

Appl. No. 09/735,572
Amdt. Dated 08/17/05
Reply to Office Action of May 17, 2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed May 17, 2005. In the Office Action, claims 1-2, 4, and 27-28 were rejected under 35 U.S.C. §102, and claims 3, 4-9, 14-22 and 29-30 were rejected under 35 U.S.C. § 103. Claims 1 and 27 have been amended. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-2, 4, and 27-28 were rejected under 35 U.S.C. §102(b) as being anticipated by Sako (U.S. Patent No. 5,689,575). Applicants respectfully traverse the rejection and contend that a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

For instance, with respect to independent claims 1 and 27, Applicants respectfully submit that Sako does not teach the operation of *suggesting* a color based on the generated histogram to *serve as the color for a template design used to display the source image. Emphasis added.* Moreover, the ratio histogram is not adapted for user color selection as now denoted in claims 1 and 27. Rather, Sako teaches generation of a ratio histogram where contents are accessed by using the input RGB image as a look-up address. *See column 6, lines 24-28 of Sako.*

In light of the foregoing, Applicants respectfully request the Examiner to withdraw the outstanding §102(b) rejection.

Rejection Under 35 U.S.C. §103

Claims 3, 8-9, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Underwood (U.S. Patent No. 6,697,825). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine*, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988). Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

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For instance, with respect to claim 8, Applicants respectfully submit that neither Sako nor Underwood, alone or in combination, teach or suggest that the suggesting of the color based on the generated histogram involves (1) providing at least one color for selection by a user and (2) allowing the user to select at least one of the provided colors. In fact, nowhere in the cited passages of these cited references discusses color selection by the user for a template design based on a generated histogram for the source image. Hence, withdrawal of the §103(a) rejection as applied to claim 8 is respectfully requested.

In addition, based on the dependency of claims 3, 8-9 and 29-30 on independent claims 1 and 27, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 3, 8-9 and 29-30 is respectfully requested.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Takayama (U.S. Patent No. 6,222,570). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. While item (57) of Takayama appears to illustrate a background of a template design, but there is no suggestion by the combined teachings of Sako and Takayama of an operation where the suggested color for subsequent user selection and based on the generated histogram for the source image, is applied to portions of the template design. Rather, it appears that Takayama teaches away from this operation by providing a static template image (57) without color modification. Hence, withdrawal of the §103(a) rejection as applied to claim 5 is respectfully requested.

In addition, based on the dependency of claim 5 on independent claim 1, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claim 5 is respectfully requested.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Sparks (U.S. Patent No. 6,167,382). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Sparks teaches generation of a menu templates that identifies prices of selected items. However, in contrast to the claimed invention, neither Sako nor Sparks, alone or in combination, teaches an operation of receiving compensation for providing the color template design. Emphasis added. Hence, withdrawal of the §103(a) rejection as applied to claim 7 is respectfully requested.

Claims 14-15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Tushie (U.S. Patent No. 6,202,155). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Moreover, Applicants respectfully traverse the Official Notice and respectfully requests evidence "computerized circuit component arrangement" which has not been fully enumerated in the Office Action as to what this terminology constitutes.

With respect to the rejection of claim 14, it is noted that the Office Action states that the source image is equivalent to the input image derived from the camera. As such, the ratio histogram is generated for colors associated with the source image, and not the template design

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as set forth in claim 14. Hence, withdrawal of the §103(a) rejection as applied to independent claim 14 is respectfully requested.

Claims 16 and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Tushie and Underwood. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Based on the dependency of claims 16 and 21-22 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 16 and 21-22 is respectfully requested.

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Tushie and Takayama. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Based on the dependency of claim 18 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claim 18 is respectfully requested.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Tushie in view of Sparks. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Based on the dependency of claim 20 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claim 20 is respectfully requested.

Claims 6 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Jammes (U.S. Published Application No. 2003/0167213). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Based on the dependency of claims 6 and 19 on independent claims 1 and 14, believed by Applicants to be in condition for allowance as noted above, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 6 and 19 is respectfully requested.

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Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: 08/17/05

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